

## **REMARKS**

Claims 1-138 were presented for examination and were pending in this application. In an Official Action dated June 24, 2003, claims 1-138 were rejected.

In response to the Examiner's objection to the application under 37 C.F.R. §1.172 regarding the written consent of the assignee, a Certificate under 37 C.F.R. §3.73(b) and the Written Consent of the Assignee in compliance with 37 C.F.R. §1.172(a), both signed by applicant's designee with signature authority for such matters are enclosed. Applicant respectfully requests that the objection be removed.

The Examiner requested correction to the format of the pending claims to conform to 37 C.F.R. §1.73(b)(2). All pending claims were reproduced below to indicate their status. In addition, the claims that were added in the preliminary amendment of December 6, 2001 are underlined to comply with 37 C.F.R. §1.73(b)(2). Original claims 1-7 and claims 8-138 added in the preliminary amendment remain unamended.

### **I. Response to Rejection Under 35 USC §102(e) in view of U.S. Patent No. 6,072,537 to Gurner et al. (Gurner)**

Claims 1, 3-5, 7-8, 10-15, 17-27, 29-33, 36-37, 40-45, 47-53, 55-60, 62-71, 73-79, 81-93, 95-105, 108, 112-119, 121-127, and 129-138 were rejected under 35 U.S.C. §102(e) as being anticipated by Gurner. This rejection is traversed as further discussed herein.

#### **A. Gurner is not prior art.**

The Gurner prior art reference has a filing and priority date of January 6, 1997. Applicant's present reissue application claims priority to abandoned patent application 08/399,013 having a filing date of March 6, 1995 (parent application). This patent application is the parent of a continuation in part application having serial no. 08/807,532, which issued

into U.S. Patent No. 6,072,933 to Green, ("Green"). The present reissue application is based on the Green patent. The subject matter for claims 1, 3-5, 6, 8, 10-15, 17-27, 29-33, 36-37, 40-45, 47-53, 55-60, 62-71, 73-79, 81-93, 95-105, 108, 112-119, 121-127, and 129-138 is supported by the specification as filed of the parent application 08/399,013, for example, at p. 2 line 30 to p.10 line 36. Pending claims 1, 3, 5, 8, 10-11, 14-15, 21, 24-26, 40-44, 47-48, 51-53, 55-56, 59, 63, 69-71, 73-74, 78, 82, 85, 91-92, 97-100, 112-115, 117-119, 121-123, 126, 130, 132, and 138 are supported, for example, at p. 4 line 14 to p. 5 line 34 of the parent application. Pending claims 12, 57, 75-76, and 124 are supported, for example at p. 6 lines 6-10 of the parent application. Pending claims 13, 58, 77, and 125 are supported, for example at p. 8 lines 32-36 of the parent application. Pending claims 17, 18, 27, 29, 30, 45, 60-62, 79, 81, 93, 95-96, and 127-129 are supported, for example at p. 6 lines 13-27 and p. 7 line 4-10 of the parent application. Pending claims 19, 64, and 83 are supported, for example at p. 5 line 35 to p. 6 line 6 of the parent application. Pending claims 20, 46, 65, 84, and 131 are supported, for example, at p. 3 line 6 and p. 5 lines 31-33 of the parent application. Pending claims 22, 66, 86, and 133 are supported, for example, at p. 7 lines 26-27 of the parent application. Pending claims 23, 31, 32, 33, 36, 37, 67, 87-90, 101-105, 108, and 134-137 are supported, for example, at p. 6 line 35 to p. 7, line 4 and 7 line 26 to p. 8, line 20 of the parent application. Pending claims 49, 50, 68, 116 are supported, for example, at p. 5, line 14 and at p. 10 lines 12-36 of the parent application. These citations are merely examples and are not intended to represent all the supporting bases in the specification for these pending claims. In view of the support found in the parent application for these pending claims, it is respectfully submitted that the Gurner reference is not prior art. Therefore, Applicant respectfully requests that the rejection under 35 U.S.C. §102(e) be withdrawn.

B. Gurner does not disclose every element of the rejected claims 4, 7, either explicitly or inherently.

Claim 4 claims a recording medium “wherein the *video signal prerecorded* (emphasis added) on the medium is predistorted.” Furthermore, the prerecorded signal is predistorted in a certain manner, that is “by enhancing the brightness of at least the lowlights of the prerecorded signal outside said background areas while maintaining the background areas at or below black level.” Gurner fails to disclose pre-distortion of the prerecorded signal. Gurner further fails to describe the particular manner of pre-distortion claimed. Gurner (See e.g. 10:5-24) describes lighting control mechanisms associated with a lighting system which vary the lighting conditions during filming of the real-time video sequence for the purpose of matching the lighting variations in the pre-existing clip, not for distinguishing the keyed portions of the pre-existing clip. One purpose of pre-distortion is to assist the mixer in distinguishing the keyed portion of a pre-recorded signal. Also, the pre-recorded signal is pre-distorted in a particular manner as claimed. Gurner does not disclose that the lowlights of the prerecorded signal outside the background areas have enhanced brightness while the background areas are at or below black level because Gurner is discussing manipulation of the real-time signal to match lighting conditions. For at least these reasons Gurner does not disclose, either explicitly or inherently, all the elements of claim 4.

Claim 7 also includes “the video signal prerecorded on the medium being predistorted by enhancing the brightness of at least the lowlights of the prerecorded signal outside said background areas while maintaining the background areas at or below black level.” The arguments with respect to claim 4 are analogous to the arguments for claim 7 so that Gurner does not disclose, either explicitly or inherently, all the elements of claim 7.

It is, therefore, respectfully requested that the rejection under 35 U.S.C. §102(e) with respect to claims 4 and 7 be withdrawn.

**II. Response to Rejection Under 35 USC §103(a) in view of Gurner and U.S. Patent No. 4,688,105 Block et al, (“Block”)**

Claims 2, 6, 28, 94 and 128 are rejected under 35 U.S.C. §103(a) as being unpatentable over Gurner in view of Block. This rejection is traversed because, inter alia, Gurner is not appropriate prior art.

The subject matter for claims 2, 6, 28, 94 and 128 is supported by the original specification of the parent application. Pending claims 2, 6, 28, 94 and 128 are supported, for example, at p. 6 lines 13-27 and at p. 7, lines 4-10 of the parent application. Therefore, it is respectfully submitted that the Gurner reference is not a prior art with respect to these claims. Each reference of a combination which is the basis of a 103(a) rejection must qualify as prior art under 35 U.S.C. §102. Therefore, it is respectfully requested that the rejection under 35 U.S.C. §103(a) with respect to claims 2,6, 28, 94 and 128 be withdrawn.

**III. Response to Rejection under 35 USC §103(a) in view of Gurner**

Claims 9, 46, 54, 72, 111 and 120 are rejected under 35 U.S.C. §103(a) as being unpatentable over Gurner. This rejection is traversed because, inter alia, Gurner is not appropriate prior art.

The subject matter for claims 9, 46, 54, 72, 111 and 120 is supported by the original specification of the parent application. Pending claims 9, 46, 54, 72, 111 and 120 are supported, for example, at p. 3 lines 12-31, p. 4 lines 14-17 and at p. 10, lines 12-17 of the parent application. Therefore, it is respectfully submitted that the Gurner reference is not a prior art with respect to these claims. Each reference of a combination which is the basis of a

35 U.S.C. §103(a) rejection must qualify as prior art under 35 U.S.C. §102. Therefore, it is respectfully requested that the 103(a) rejection with respect to claims 9, 46, 54, 72, 111 and 120 be withdrawn.

**IV. Response to Rejection Under 35 USC §103(a) in view of Gurner and Block and further in view of U.S. Patent No. 5,016,113 to Yamashita et al. ("Yamashita")**

Claims 16, 34-35, 38-39, 61, 80, 106-107, and 109-110 are rejected under 35 U.S.C. §103(a) as being unpatentable over Gurner in view of Block and further in view of Yamashita. This rejection is traversed because, inter alia, Gurner is not appropriate prior art.

The subject matter for claims 16, 34-35, 38-39, 61, 80, 106-107, and 109-110 is supported by the original specification of the parent application. Pending claims 16, 34-35, 38-39, 61, 80, 106-107, and 109-110 are supported, for example, at p. 6 lines 13-25, p. 7 lines 4-10 and at p. 8, lines 22-30 of the parent application. Therefore, it is respectfully submitted that the Gurner reference is not prior art with respect to these claims. Each reference of a combination which is the basis of a 35 U.S.C. §103(a) rejection must qualify as prior art under 35 U.S.C. §102. Therefore, it is respectfully requested that the rejection with respect to claims 16, 34-35, 38-39, 61, 80, 106-107, and 109-110 be withdrawn under 35 U.S.C. §103(a).

**Conclusion**

In sum, Applicant respectfully submits that pending claims 1-138, as presented herein, are patentably distinguishable over the cited references (including references cited, but not applied). Therefore, Applicant requests reconsideration and allowance of these claims.

In addition, Applicant respectfully invites Examiner to contact Applicant's representative at the number provided below if Examiner believes it will help expedite furtherance of this application.

RESPECTFULLY SUBMITTED,  
David Green

Date: November 24, 2003

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Atty. Dkt. No.: 22728-06523

## Certificate Under 37 CFR § 3.73(b)

Applicant:

David Green

Patent No.:

6,072,933

Issue Date:

June 6, 2000

Name of Assignee:

SBS Interactive, Inc.

Type of Assignee (e.g. corporation, partnership, university, government agency, etc.):

Corporation

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DEC 05 2003

Technology Center 2600

The above-mentioned Assignee certifies that it is the assignee of the entire right, title and interest in the patent application identified above by virtue of either:

- A. ☐ An assignment from the inventor(s) of the patent application identified above. The assignment was recorded in the Patent and Trademark Office at Reel \_\_\_\_\_, Frame \_\_\_\_\_, or for which a copy thereof is attached; OR
- B. ☒ A chain of title from the inventor(s), of the patent application identified above, to the current assignee as shown below:

1. From: David Green

To: High Plateau Holdings, Inc.

The document was recorded in the Patent and Trademark Office at

Reel: 014097 and Frame: 0752, or for which a copy thereof is attached.

2. From: High Plateau Holdings, Inc.

To: SBS Interactive, Inc.

The document was recorded in the Patent and Trademark Office at

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3. From: \_\_\_\_\_

To: \_\_\_\_\_

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☐ Additional documents in the chain of title are listed on a supplemental sheet.

☐ Copies of assignments or other documents in the chain of title are attached.

The undersigned has reviewed all the documents in the chain of title of the patent application identified above and, to the best of undersigned's knowledge and belief, title is in the assignee identified above.

The undersigned (whose title is supplied below) is empowered to sign this certificate on behalf of the assignee.

I hereby declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true; and further, that these statements are made with the knowledge that willful false statements, and the like so made, are punishable by fine or imprisonment, or both, under Section 1001, Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Nov 24/03

Date

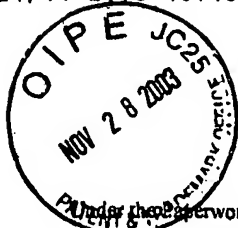
Signature

Todd Gottlieb

Name

Chairman, SBS Interactive, Inc.

Title



PTO/SB/33 (10-00)

Approved for use through 12/30/2000. OMB 0651-0033

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**REISSUE APPLICATION: CONSENT OF ASSIGNEE;  
STATEMENT OF NON-ASSIGNMENT**

Docket Number (Optional)

22728-06523

This is part of the application for a reissue patent based on the original patent identified below

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Name of Patentee(s)

David Green

DEC 05 2003

Technology Center 2000

Patent Number

6,072,933

Date Patent Issued

June 6, 2000

Title of Invention

SYSTEM FOR PRODUCING PERSONALIZED VIDEO RECORDINGS

1. ☒ Filed herein is a statement under 37 CFR 3.73(b). (Form PTO/SB/96)
2. ☐ Ownership of the patent is in the name of the inventor(s), and no assignment of the patent is in effect.

One of boxes 1 or 2 above must be checked. If multiple assignees, complete this form for each assignee. If box 2 is checked, skip the next entry and go directly to "Name of Assignee."

The written consent of all assignees and inventors owning an undivided interest in the original patent is included in this application for reissue.

The assignee(s) owning an undivided interest in said original patent is/are **SBS Interactive, Inc.**, and the assignee(s) consents to the accompanying application for reissue.

Name of assignee/inventor (if not assigned)

SBS Interactive, Inc.

Signature

Date

Nov. 24/03

Typed or printed name and title of person signing for assignee (if assigned)

Todd Gotlieb

Chairman, SBS Interactive, Inc.